

and *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977). The burden of proof was shifted to the applicant in *In re Fitzgerald* and *In re Best* because the prior art was "identical or only slightly different from product claimed in product-by-process claim". In the present case, the fabric product claims of the present invention have been compared to a published European Patent Application on an emerizing machine to treat textiles (EP 0 784 114 A1, hereinafter "Huth"). There is no description in Huth of a product having the characteristics of the present invention. It was asserted in the Office Actions that the process in Huth is so substantially similar to the process described in the specification of the present application to obtain the claimed product, that a shift of the burden under 35 USC 102(b) and 35 USC 103(a) is justified according to *In re Fitzgerald* and *In re Best*.

Huth describes an "emerizing machine with an emerizing cylinder which has attached to it parallel to its axis of rotation closely spaced strip-shaped emerizing elements." See translation, first page, first sentence. Huth states that the "cylinder serves to process a pile fabric with said emerizing element by passing it under tension and in wiping contact past its surface." See translation, first page, second sentence (starting on third line). There is no teaching in Huth of the type of pile to treat (e.g., loop or free end), the type or size of abrasive matter, the material the pile is formed of, amount or speed of the abrasion, etc. For example, the prior art equipment could have been used with large abrasive particles on loop piles of spun cotton staple yarns at a speed that merely brakes the individual cotton staple fibers loose from the yarns of the loop piles without influencing the character of the individual cotton staple fibers. Applicants respectfully submit that it is not reasonable to assume that this type of pile fabric processed in this manner would be identical or only slightly different from the claimed invention. This example would be dramatically different from the claimed invention, and is no less speculative than the assumption that the application of the device in Huth would result in the Claimed invention. Therefore, Applicants respectfully submit there is an insufficient basis to assert that the cited prior art is "identical or only slightly different" from the claimed product, that there is insufficient basis under *In re Fitzgerald* and *In re Best* to shift the burden to the Applicants, and that a prima facie case of anticipation and obviousness has not been established.

Furthermore, Applicant's respectfully submit that the cited prior art does not anticipate the invention in Claims 3 and 4. The rejection under 35 USC 102(b) is not a rejection of a claimed product with a reference describing a prior art product, but the rejection of a claimed product with a reference describing a process to apply to a product. Therefore, the rejection cannot stand unless the claimed product inherently (i.e., necessarily) results from the process described in Huth. As previously pointed out, many variables in the process have been omitted from Huth. For example, the prior art reference does not indicate if the pile is a free end pile or a loop pile. In contrast, Claims 3 and 4 specifically require a free end pile. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that that a certain thing may result from a given set of circumstance is not sufficient.'" *In re Robertson*, 169 F.3rd 743,745, 49 USPQ2d 1949,

1950-51 (Fed. Cir. 1999) (citations omitted); see also MPEP 2112, Page 2100-51. Therefore, Applicants respectfully submit that the inventions in Claims 3 and 4 are not anticipated by the cited reference.

Additionally, Applicants respectfully submit that the invention in Claims 3 and 4 is not obvious over Huth. Once again, this is not rejection of product with a prior art product, but the use of a prior art process to reject a product. As previously pointed out, Huth is so lacking in details on the fabric or the process to the fabric that vastly different products could result from the application of the machine in that reference to a "pile" fabric. Huth gives no reason for the application of the abrasive bristles to a pile fabric, or how to obtain particular characteristics of the pile fabric by applying the prior art machine. Nor does Huth teach or suggest a fabric with the characteristics as in the Claimed invention. There is no teaching, suggestion, or motive to modify the application of the machine in the cited prior art to obtain the particular properties of the claimed invention. The only way to add the needed information for Huth to form the present invention, is by the use of the present invention as a blueprint for the motivation and missing information. Therefore, Applicants respectfully submit that Claims 3 and 4 are not obvious in view of Huth.

2. Rejection of Claims 1, 2, and 5 Under 35 USC 103(a)

Claims 1, 2, and 5 were rejected under 35 USC 103(a) as being obvious over Huth. Huth does not disclose the particular characteristics of the claimed invention. It was asserted in the Office Actions, however, that the process in Huth is so substantially similar to the process described in the specification of the present application to obtain the claimed product, that a shift of the burden under 35 USC 102(b) and 35 USC 103(a) is justified according to *In re Fitzgerald* and *In re Best*.

As asserted above with respect to Claims 3 and 4, Applicants respectfully submit that a prima facie case of obviousness has not been established for Claims 1, 2, and 5, and the burden of proof has been impermissibly shifted to Applicants under *In re Fitzgerald* and *In re Best*. As shown above, it is the process in Huth that is being used to reject the claimed invention. Also as shown above, Huth is so lacking in details of the process to produce the claimed invention, that many products dissimilar to the claimed invention could be produced from Huth. As another example, the pile density of the fabric and the density of the abrasive bristles in Huth could be selected such that the bristles pass between the piles to abrade the piles in a direction perpendicular to the pile length. In contrast, Claims 1 and 2 specifically requires abrasions along the length direction (distal end to proximal end). Therefore, Applicants respectfully submit there is an insufficient basis to assert that the cited prior art is "identical or only slightly different" from the claimed product, that there is insufficient basis under *In re Fitzgerald* and *In re Best* to shift the burden to the Applicants, and that a prima facie case of anticipation and obviousness has not been established.

Additionally, Applicants respectfully submit that the invention in Claims 1, 2, and 5 is not obvious over Huth. Huth does not disclose a pile fabric having any particular characteristics, let alone the characteristics of the pile fabric in the claimed invention. The rejection of Claims 1, 2, and 5, is not rejection of product with a prior art product,

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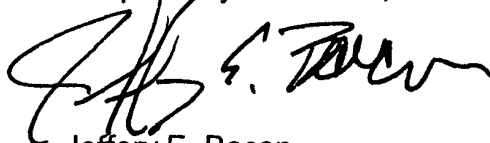
but the use of a prior art process to reject a product. As previously pointed out, Huth is so lacking in details on the fabric or the process to the fabric that vastly different products could result from the application of the machine in that reference to a "pile" fabric. Huth gives no reason for the application of the abrasive bristles to a pile fabric, or how to obtain particular characteristics of the pile fabric by applying the prior art machine. Nor does Huth teach or suggest a fabric with the characteristics as in the Claimed invention. There is no teaching, suggestion, or motive to modify the application of the machine in the cited prior art to obtain the particular properties of the claimed invention. The only way to add the needed information for Huth to form the present invention, is by the use of the present invention as a blueprint for the motivation and missing information. Therefore, Applicants respectfully submit that Claims 1, 2, and 5 are not obvious in view of Huth.

Applicant having addressed all of the rejections, objections, and comments in the latest Office Action, respectfully requests reconsideration and allowance of the pending claims in view of the above Amendments and Remarks. Applicant respectfully submits that the amendments submitted herewith do not add new matter to the application. In the event that the Examiner believes that the claims would be allowable with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment.

Fee Authorization: In the event that there are additional fees associated with the submission of these papers, Applicant hereby authorizes the Commissioner to withdraw those fees from our Deposit Account No. 04-0500.

Extension of Time: In the event that additional time is required to have the papers submitted herewith for the above referenced application to be considered timely, Applicant hereby petitions for any additional time required to make these papers timely and authorization is hereby granted to withdraw any additional fees necessary for this additional time from our Deposit Account No. 04-0500.

Respectfully Submitted,



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